

### **REMARKS**

Claims 1-27 remain pending in this application and are presented for reconsideration. Claims 1, 6, 12, 14, and 23 are amended without any intent of disclaiming equivalents thereof. Claims 11, 13, and 25-27 are rewritten in independent form and include all the limitations of their respective base claims and any intervening claims.

Support for amendments to claims 1, 6, and 23 can be found throughout the Specification, for example, at paragraphs 29, 34, and 35. Claims 12 and 14 are amended to correct claim dependency. Applicants respectfully submit that the amendments do not introduce new matter.

#### **Rejections under 35 U.S.C. § 112, first paragraph**

Claim 16 stands rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Specifically, the Office action states that it is not clear from the description how rotation of the cylinder can be adjusted to adjust the force of the web thereagainst as recited in claim 16.

Applicants respectfully traverse this rejection. The fundamental factual inquiry in a written description rejection is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date, applicant was in possession of the invention as now claimed. An applicant shows possession of the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. MPEP 2163.02.

In this regard, Applicants direct the Office's attention to paragraph 50 on page 14 of the specification:

Referring back to FIG. 3, the actuation device 360 useful in an on-press printing system may include multiple components such as a cylinder drive 362, a cylinder motor 366, a motor 371 for a web-supply spool, and a motor 372 for a web-uptake spool. Through these components, the actuation device 360 may adjust the web normal force through rotating the cylinder 100, the web-supply, the web-uptake spool, or any combination of the above. As the web is tightened, the

normal force exerted by the web increases, and vice versa. The actuation device 360 may involve a drive or a brake.

Upon reading the above-quoted passage, in combination with FIG. 3, one skilled in the art would readily realize that the cylinder motor 366, which is connected to a cylinder drive 362, may speed up the rotation of the cylinder 100, or slow down the rotation, for example, by actuating a brake, thereby adjusting web force against the cylinder.

Accordingly, Applicants respectfully submit that the specification has met the written description requirement since it conveys with reasonable clarity to those skilled in the art that, as of the filing date, applicant was in possession of the invention as now claimed in claim 16. Applicants respectfully request the reconsideration and withdrawal of the rejection in view of the reasons stated above.

Rejections under 35 U.S.C. § 112, second paragraph

Claim 12 stands rejected under 35 U.S.C. § 112, second paragraph, for being indefinite. Specifically, the Office action states antecedent basis for the phrase “the positioning device” is lacking and suggests that claim 12 would be free from the rejection if it depends from claim 11. Applicants have amended claim 12 according to the Examiner’s suggestion and respectfully submit that the rejection based on 35 U.S.C. § 112, second paragraph, over claim 12 has been overcome, and respectfully request the withdrawal of the rejection.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 3, 6-9, 18, 19, 21, 23, and 24 stand rejected under 35 U.S.C. § 102 over U.S. Patent No. 5,878,933 to Laughery (hereinafter “Laughery”). Claims 1, 2, 5-9, 17-19, and 22-24 stand rejected under 35 U.S.C. § 102 over U.S. Patent No. 5,553,801 to Lee (hereinafter “Lee”). Claims 1-3, 6-9, 17-20, 23, and 24 stand rejected under 35 U.S.C. § 102 over U.S. Patent No. 5,039,027 to Yanagihara *et al.* (hereinafter “Yanagihara”). Therefore, all three independent claims, namely, claims 1, 6, and 23, were rejected as being anticipated by each of Laughery, Lee, and Yanagihara.

Applicants have amended each of claims 1, 6, and 23 by reciting that the sensing device or sensor is affixed to or implanted within a circumferential surface of a web-handling cylinder. In contrast, none of the three cited references disclose or suggest this limitation. In Laughery, the “pressure sensing means 72,” referenced in the Office action, is separate from the web-handling cylinders 104, 106, or 2 (FIG. 3), and not affixed to or implanted within the cylinder’s circumferential surface.

Similarly, in Lee, a piezoelectric sheet 20, also referenced in the Office action, forms the surface of a guide pole 30, which is also separate from the cylinder 5 (head drum) that handles the magnetic tape 10 (FIG. 1). In Yanagihara, neither potentiometers 12 or 13 is affixed to or implanted within a web-handling cylinder (FIG. 1).

Accordingly, none of Laughery, Lee, or Yanagihara teaches or suggests all the limitations of independent claims 1, 6, or 23, as amended. Therefore, Applicants respectfully submit that the rejections over claims 1, 6, 23, and their respective dependent claims, under 35 U.S.C. § 102 have been overcome, and respectfully request reconsideration and withdrawal of all the rejections.

#### Rejections under 35 U.S.C. § 103

Claims 10 stands rejected under 35 U.S.C. § 103 over Laughery, Lee, or Yanagihara. Claim 6, 9, 10, 14, and 15 stand rejected under 35 U.S.C. § 103 over U.S. Patent No. 6,325,322 to Lewis (hereinafter “Lewis”) in view of Lee.

Claim 10 depends from claim 6, and as discussed above, none of Laughery, Lee, or Yanagihara teaches or suggests all the limitations of independent claim 6 as amended. Therefore, a rejection of claim 10 under 35 U.S.C. § 103 based on any of these three references cannot be sustained.

With regard to the rejection of claims 6, 9, 10, 14, and 15 based on Lewis in view of Lee, Lewis does not cure the deficiency of Lee as Lewis does not teach or suggest a sensing device. Accordingly, Applicants respectfully submit that all rejections over claims 6, 9, 10, 14, and 15

under 35 U.S.C. § 102 have been overcome, and respectfully request reconsideration and withdrawal of all the rejections.

Allowable Subject Matter

Claims 11, 13, and 25-27 have been indicated as directed to allowable subject matter. Claims 11, 13, and 25-27 are rewritten in independent form and include all the limitations of their respective base claims and any intervening claims. Accordingly, claims 11, 13, and 25-27 should be allowable.

Summary

In view of the foregoing, Applicants submit that all pending claims, namely, claims 1-27 are in condition for allowance. Applicants respectfully request entry of this Amendment and Response, reconsideration, and early favorable action by the Examiner.

The Examiner is cordially invited to contact Applicants' undersigned representative at the number listed below to discuss any outstanding issues.

Date: January 5, 2005  
Reg. No. (Limited Recognition)  
(attached)

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Respectfully submitted,



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